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EXAMINER

MCLEAN, NEIL R

ART UNIT	PAPER NUMBER
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2625

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)
	10/733,102	ELKADY ET AL.
	Examiner	Art Unit
	Neil R. McLean	2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 05 November 2007.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-28 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) Notice of Informal Patent Application
- 6) Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments, see Amendment - After Non-Final Rejection, filed 11/05/2007, with respect to Non-Statutory Subject Matter have been fully considered, and the amendments to the related claims is noted. The rejection of claims 15-28 has been withdrawn.

2. Applicant's arguments; see Applicant Arguments/Remarks Made in an Amendment, filed 11/05/2007, with respect to the rejection(s) of claim(s) 1-28 under Schwier et al. (US 7,202,972) have been fully considered but are not persuasive.

Regarding Applicant's Argument:

"Schwier does not use a **merge utility** executing on the computer system".....

"Rather Schwier relies on the output device to perform the step of merging".

Examiner's Response:

Column 4, lines 8-20 teaches the variable data area of the master document is replaced (merged) record by record in the application 10 (merge utility) by corresponding variable data (another document).

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-28 are rejected under 35 U.S.C. 102(e) as being anticipated by Schwier et al. (US 7,202,972).

Regarding Claim 1:

Schwier et al. discloses a method comprising:

receiving (In order to merge the system must receive a merge command from the browser or program code), at a merge utility (e.g., Winword Application 10 in Figure 2) executing on a computer system (e.g., Personal Computer 1 in Figure 1), a first merge document (e.g., Static Data 12 created by WinWord Application 10 in Figure 2) that is in a merge format;

converting a second document (e.g., Excel document) from an original format to the merge format to create a second merge document (e.g., Master Document described in Column 9, lines 32-35);

wherein the second document was created by a first document authoring application (e.g., WinWord Program 10 in Figure 2);

wherein the step of converting is performed by either the merge utility or the first document authoring application (e.g., Column 5, lines 23-43);

using the merge utility, merging the first merge document (e.g., Variable Data V) and the second merge document (e.g., Static Data S) to generate a composite merge document (e.g., V+S (EMF) 13 in Figure 2); and

delivering said composite merge document to an output device (e.g., Figure 8 is a functional block diagram of a print operation; Column 9, lines 1-3);

wherein the original format is a format that is not supported by the output device (e.g., Step 47 "Is Output Format EMF?" in Figure 8; described in Column 9, lines 25-34); and

therefore needs to be converted to another format that is supported by the output device in order to be properly interpreted by the output device (Referring to Figure 8; When the query to "Is Output Format EMF?" yields "NO"; Kernel Mode 53 is activated; Described in Column 9, lines 25-34); and

wherein the merge format is a format that is supported by the output device (Referring to Figure 8; When the query to "Is Output Format EMF?" yields "YES"); and

therefore does not need to be converted to another format that is supported by the output device in order to be properly interpreted by the output device (Described in Column 9, lines 11-24).

Regarding Claim 2:

Schwier et al. further discloses the method of claim 1 further comprising: generating the first merge document in said merge format by converting a first original document from an original format to the merge format (See PCL converter 18 in Figure 2).

Regarding Claim 3:

Schwier et al. further discloses the method of claim 1, wherein the merge format is Standard Printing and Imaging Format (SPIF) (Column 3, lines 61-64; 'the conversion of the data stream into a print language such as PCL or postscript').

Regarding Claim 4:

Schwier et al. further discloses the method of claim 3, wherein the merge format is PDL Postscript (Column 3, lines 61-64; 'the conversion of the data stream into a print language such as PCL or postscript').

Regarding Claim 5:

Schwier et al. further discloses the method of claim 1, wherein the first document is a background template document and the second document is an overlay document (Column 8, lines 64-67; 'The placement type as an **overlay** (complete superimposition) **or a watermark** (macro information only in the background) within the document **can be selected** with the selection field 44').

Regarding Claim 6:

Schwier et al. further discloses the method of claim 5, wherein the background template document is originally created by a second document authoring **application** (Column 5, lines 23-30; 'Various application programs in turn run under this operating system, for example the **application** 10 Winword 97.RTM. from the Microsoft Office 97.RTM. package'); and wherein the second document authoring application is different (Column 5, lines 35-38; 'The variable data areas are intended to be filled with variable data that are stored in a separate datafile (a Word document, data bank, an Excel document, etc.) from said first document authoring application.

Regarding Claim 7:

The method of claim 5, wherein the background template document is created in a second original format (Column 5, lines 35-38; 'The variable data areas are intended to be filled with variable data that are stored in a separate datafile (a Word document, data bank, an Excel document, etc.) and converted from the second original format to the merge format (See PCL converter 18 in Figure 2).

Regarding Claim 8:

Schwier et al. further discloses the method of claim 7, wherein the conversion of the second original document to the merge format occurs at the merge utility (Column 7, lines 4-6; 'these **variable data** 15 are then merged by an OR-operation with the static data stored in the

memory 8 to form merged variable and static data 19').

Regarding Claim 9:

Schwier et al. further discloses the method of claim 1, wherein the converting of the second document from the original format to the merge format to create the second merge document includes:

generating, based on the original format, a set of conversion instructions (The program code or device which enables the PCL converter 18 in Figure 2) to convert the second document into said second merge document;

passing the set of conversion instructions to a document authoring application (Column 4, lines 15-20); and

the first document authoring application generating the second merge document based on said set of conversion instructions (Column 4, lines 15-20).

Regarding Claim 10:

Schwier et al. further discloses the method of claim 1, wherein the method further comprises receiving a request to merge documents containing information about a document authoring application (Column 4, lines 25-26; 'the referencing is thereby particularly controlled via data that are input via a user interface') that created the second document; and

wherein the converting of the second document from the original format to the merge format to create the second merge document includes:

generating, based on the information about the document authoring application, a set of conversion instructions (The program code or device which enables the PCL converter 18 in Figure 2) to convert the second document into said second merge document;

passing the set of conversion instructions to the document authoring application (Column 9, lines 59-62; "Enhanced Print Environment (EPE) Print Processor" 49a does not forward the EMF data directly to the port monitor 51 but calls the converter unit 58, wherein the EMF data stream is converted into a PCL print data stream 60'); and

the document authoring application generating the second merge document based on said set of conversion instructions (Column 9, lines 65-67, 'The conversion is thereby controlled by the parameters that were previously input via the input module 59').

Regarding Claim 11:

Schwier et al. further discloses the method of claim 1, wherein the composite merge document is in the merge format (Column 3, lines 56-67).

Regarding Claim 12:

Schwier et al. further discloses the method of claim 1, wherein the composite merge document is a **template** for creating other documents (FIG. 5 shows a **master** document 25).

Regarding Claim 13:

Schwier et al. further discloses the method of claim 1, further comprising performing the step of merging the first document and the second document in response to receiving, at the merge utility, a request to merge documents (The program code or device which enables the devices shown in Figure 1 to initiate a request to merge command).

Regarding Claim 14:

Schwier et al. further discloses the method of claim 1 further comprising: receiving at the merge utility, a request to merge documents (Column 7, lines 20-25; in order to merge the system must receive a merge command); generating the first merge document in said merge format by converting a first original document from an original format to the merge format (See PCL converter 18 in Figure 2); wherein the merge format is Standard Printing and Imaging Format (SPIF) (Column 3, lines 61-64; 'the conversion of the data stream into a print language such as PCL or postscript'); wherein the first document is a background template document and the second document is an overlay document (Column 8, lines 64-67; 'The placement type as an overlay (complete superimposition) or a watermark (macro information only in the background) within the document can be selected with the selection field 44'). wherein the background template document is originally created by a first document authoring application; and

wherein the second document authoring application that is different from said first document authoring application;

wherein the background template document is created in a second original format and converted from the second original format to the merge format.

Regarding Claim 15:

Schwier et al. further discloses a machine-readable storage medium storing one or more sequences of instructions, which when executed by one or more processors, causes the one or more processors to perform the method recited in claim 1 (The program code or device which performs the functions described in Claim 1).

Regarding Claim 16:

Schwier et al. further discloses a machine-readable storage medium storing one or more sequences of instructions, which when executed by one or more processors, causes the one or more processors to perform the method recited in claim 2 (The program code or device which enables the PCL converter 18 in Figure 2 to initiate the method described in Claim 2).

Regarding Claim 17:

Schwier et al. further discloses a machine-readable storage medium storing one or more sequences of instructions, which when executed by one or more processors, causes the one or more processors to perform the method recited in claim 3 (The

program code or device which performs the function described in (Column 3, lines 61-64; 'the conversion of the data stream into a print language such as PCL or postscript').

Regarding Claim 18:

Schwier et al. further discloses a machine-readable storage medium storing one or more sequences of instructions, which when executed by one or more processors, causes the one or more processors to perform the method recited in claim 4 (The program code or device which performs the function described in (Column 3, lines 61-64; 'the conversion of the data stream into a print language such as PCL or postscript').

Regarding Claim 19:

Schwier et al. further discloses a machine-readable storage medium storing one or more sequences of instructions, which when executed by one or more processors, causes the one or more processors to perform the method recited in claim 5 (The program code or device which performs the function described in Column 8, lines 64-67; 'The placement type as an **overlay** (complete superimposition) **or a watermark** (macro information only in the background) within the document **can be selected** with the selection field 44').

Regarding Claim 20:

Schwier et al. further discloses a machine-readable storage medium storing one or more sequences of instructions, which when executed by one or more processors, causes the one or more processors to perform the method recited in claim 6 (The

program code or device which performs the functions described in Claim 6).

Regarding Claim 21:

Schwier et al. further discloses a machine-readable storage medium storing one or more sequences of instructions, which when executed by one or more processors, causes the one or more processors to perform the method recited in claim 7 (The device or program code which performs the functions described in Claim 7).

Regarding Claim 22:

Schwier et al. further discloses a machine-readable storage medium storing one or more sequences of instructions, which when executed by one or more processors, causes the one or more processors to perform the method recited in claim 8 (The program code or device which performs the function described in (Column 7, lines 4-6; 'these **variable data 15** are then merged by an OR-operation with the static data stored in the memory 8 to form merged variable and static data 19').

Regarding Claim 23:

Schwier et al. further discloses a machine-readable storage medium storing one or more sequences of instructions, which when executed by one or more processors, causes the one or more processors to perform the method recited in claim 9 (The program code or device which performs the function described in Claim 9).

Regarding Claim 24:

Schwier et al. further discloses a machine-readable storage medium storing one or more sequences of instructions, which when executed by one or more processors, causes the one or more processors to perform the method recited in claim 10 (The program code or device which performs the function described in Claim 10).

Regarding Claim 25:

Schwier et al. further discloses a machine-readable storage medium storing one or more sequences of instructions, which when executed by one or more processors, causes the one or more processors to perform the method recited in claim 11 (The program code or device which performs the function described in Column 3, lines 56-67).

Regarding Claim 26:

Schwier et al. further discloses a machine-readable storage medium storing one or more sequences of instructions, which when executed by one or more processors, causes the one or more processors to perform the method recited in claim 12 (The program code or device which performs the function as described in Claim 12).

Regarding Claim 27:

Schwier et al. further discloses a machine-readable storage medium storing one or more sequences of instructions, which when executed by one or more processors, causes the one or more processors to perform the method recited in claim 13 (The program code or device which enables the devices shown in Figure 1 to initiate a request to merge command).

Regarding Claim 28:

Schwier et al. further discloses a machine-readable storage medium storing one or more sequences of instructions, which when executed by one or more processors, causes the one or more processors to perform the method recited in claim 14 (The program code or device which describes the process as described in Claim 14).

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Sciatto (US 6,330,073) discloses A system and method for generating a plurality of customized documents having at least one portion of common information and at least one portion of variable information.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

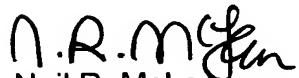
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

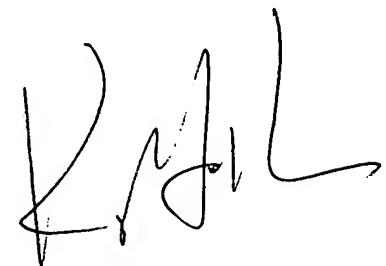
TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neil R. McLean whose telephone number is 571.270.1679. The examiner can normally be reached on Monday through Friday 7:30AM-5:00PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, King Poon can be reached on 571.272.7440. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Neil R. McLean
01/18/2008



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